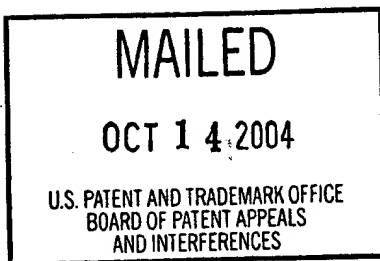


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte YUE HENG XU

Appeal No. 2003-1952
Application No. 09/409,366

ON BRIEF

Before THOMAS, KRASS, and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-18.

The invention is directed to a method for implementing electronic programming guides (EPGs) and is best described by reference to representative independent claim 1, reproduced as follows:

1. A method of implementing an electronic programming guide through a program receiver comprising:

Appeal No. 2003-1952
Application No. 09/409,366

providing access to a first electronic programming guide with a first set of program selections over a first medium;

providing access to a second electronic program guide with a second set of program selections over a second medium; and

enabling a user to select, over said first and second media, programs for viewing on said receiver.

The Examiner relies on the following references:

Klosterman	5,550,576	Aug. 27, 1996
Stautner et al. (Stautner)	6,172,677	Jan. 09, 2001
		(filed Oct. 07, 1996)

Claims 1-18 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Stautner and Klosterman with regard to all claims.

Reference is made to the brief¹ and answer² for the respective positions of Appellant and the Examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John

¹ Appeal brief filed February 27, 2003 (Paper No. 15)

² Examiner's answer mailed April 9, 2003 (Paper No. 16).

Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could

have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)], [now 41.37(c)(1)(vii)³].

With regard to independent claim 1, the Examiner relies on figure 2, figure 5, and column 4, lines 58-60, of Stautner for a teaching providing access to a first EPG with a first set of program selections (figure 5), access to a second EPG with a second set of program selections (figure 2), and enabling the user to select viewing programs (column 4, lines 58-60). The Examiner acknowledges that Stautner lacks a teaching that a first and second EPGs are provided over a first and second medium. However, the Examiner asserts that providing EPGs over different media is known in the art and points to a teaching in Klosterman at column 6, lines 12-14, that EPGs can be transmitted via different mediums, to confirm the assertion. As motivation to combine the two references, the Examiner points to a teaching in Klosterman at column 6, lines 1-11, that providing EPGs over a different medium reduces the memory requirements of the system.

We agree with the Examiner's reasoning and therefore conclude that the Examiner has met his burden of presenting a prima facie case of obviousness. The burden is therefore shifted to Appellant to overcome the rejection with argument and/or evidence of rebuttal.

In this regard, Appellant is silent as to the Examiner's application of Stautner, and merely argues that Klosterman at best only teaches "one programming guide and two media". [Appeal brief, page 11, lines 2-3]. Essentially, it seems that Appellant is arguing that Klosterman is not properly applied under 35 U.S.C. § 103.

We disagree.

It is clear from the record that the Examiner has not held Klosterman as teaching the first and second EPGs provided over a first and second media. The Examiner presents Stautner as having first and second EPGs and allowing the user to select the programs over each. The Examiner only points to Klosterman for the teaching of providing two media for transmitting data and notes Appellant's admission of such at page 11, paragraph 1 of the appeal brief where Appellant refers to Klosterman at column 6, lines 1-14. [See also, Klosterman at column 5, lines 54-57 and column 7, lines 13-17]. We agree with the Examiner and find that Appellant has failed to properly challenge the Examiner's application of 35 U.S.C. § 103. Furthermore, the lack of any arguments attacking the Examiner's application of Stautner does not convince us of any

error in the Examiner's position. Additionally, Appellant concedes that Klosterman teaches the subject matter the Examiner utilizes to modify Stautner. Finally, Appellant never challenges the Examiner's combination of the references. As mentioned above, only those arguments actually made by Appellant have been considered in this decision, and arguments which Appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived. Therefore, we will sustain the rejection of claims 1-18 under 35 U.S.C. § 103.

In the alternative, we find that Klosterman explicitly teaches the collecting of more than one EPG from multiple sources, mixing/sorting them, and allowing the user to select programs over each. [Klosterman column 5, lines 54-57, and column 7, lines 13-17]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Stautner with the compiling of different EPGs from different media as taught by Klosterman in order to provide the user with an easy means by which to select programming when provided by more than one input. It is well established that the Board may use parts of a reference ignored by the Examiner when applying that reference without constituting a new ground of rejection. In re Meinhardt, 392 F.2d 273, 280, 157 USPQ 270, 275 (CCPA 1968) ("it is proper for the court and necessarily, the board, to consider everything that a reference discloses.").

Appeal No. 2003-1952
Application No. 09/409,366

Further in support of our conclusion, as mentioned above, we find no arguments in the brief regarding the Examiner's application of Stautner. It is well established that one cannot attack references individually where the rejection is based on a combination of references. In re Merck, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). Again, Appellant failed to meet his burden by not presenting arguments directed to the Stautner reference, and any such arguments have been waived.

Claims 2-18 fall with independent claim 1, so we will also sustain the rejection of claims 2-18 under 35 U.S.C. § 103.

Accordingly, the Examiner's decision rejecting claims 1-18 under 35 U.S.C. § 103 is affirmed.

Appeal No. 2003-1952
Application No. 09/409,366

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED

JAMES D. THOMAS
Administrative Patent Judge

ERROL A. KRASS
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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Appeal No. 2003-1952
Application No. 09/409,366

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